REMARKS

Claims 1 and 3-12 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to more specifically characterize the nature of the bonding between the first material and the second material about the apertures. Support for this amendment can be found at page 15, lines 12-17.

Claims 3-12 have been amended to correct a transcriptional error which occurred during the prosecution of a previous response dated June 26, 2003. Applicants inadvertently presented claims 3-12 as originally filed with the application rather than claims 3-12 which were submitted via the preliminary amendment filed on October 5, 2000. Claims 3-12 have been amended to reflect the amendments submitted via the preliminary amendment filed on October 5, 2000.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Objections

The Office Action has objected to the amendment made to claim 1 by the Applicants' response dated June 26, 2003 under 35 U.S.C. § 132 as introducing new matter. The Office Action alleges that the phrase "fibers of the first and second material are substantially unbroken" is unsupported by the specification and is therefore new matter. Applicants have amended claim 1 eliminating the alleged new matter therefrom.

The Office Action has objected to claim 3 because the claim alternatively depends on claim 2 which has been canceled. Applicants have amended claim 3 such that it depends solely from claim 1.

The Office Action has objected to the specification because it fails to provide proper antecedent basis for the claimed subject matter, specifically with regard to the fibers of the first and second material being substantially unbroken. Applicants have amended claim 1 such that the limitation in question has been removed.

Rejection Under 35 USC 103(a) Over Gilman et al.

The Office Action has rejected claims 1 and 3-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,437,653 issued to Gilman et al. Applicants respectfully traverse

the rejection by the Office Action because the Office Action has failed to establish a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* The Office Action has failed to establish a *prima facie* case of obviousness because there is no motivation to modify the cited reference and the cited reference fails to teach or suggest all of the claim limitations of the claimed invention.

First the Gilman et al. reference fails to teach or suggest all of the claim limitations of the claimed invention. The Gilman et al. reference theorizes, "that in the aperturing process, some of the fibers 28 are broken and pushed down into the absorbent layer 20 by the penetration of the aperturing pins. (col. 5, lines 43-45). "As these broken fibers are pushed down into the absorbent layer 20, they tend to embed themselves in the fibers of the absorbent layer 20." (col. 5, lines 45-48). The Gilman et al. reference also teaches, that the embedding of these broken fibers is "important because it prevents the fibers 28, which can be relatively stiff fibers, from moving upward as the aperture pins are withdrawn" thereby eliminating the presence of course fibers. (col. 5, lines 47-52). Because the Gilman et al. reference teaches that the embedding of the broken fibers eliminates the presence of course fibers, the Gilman et al. reference does not teach or suggest all of the claim limitations of amended claim 1. Namely, the Gilman et al. reference fails to teach or suggest "a plurality of fibers of said first material and a plurality of fibers of said second material are substantially fused together about the apertures," as recited, in part, in amended claim 1.

Also, the Office Action states:

> Gilman discloses that the first material provides a dry surface against the skin of the wearer and in col. 3, lines 3 -14, Gilman discloses suitable materials for the first material. The disclosed materials (polymers) are hydrophobic. Gilman calls the second material an absorbent layer. Gilman does not disclose this layer to be hydrophilic.
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> However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the second material hydrophilic in order to enhance the absorbency of that layer because it is after all an absorbent layer, and an absorbent layer is intended to absorb fluids. If the second material is hydrophilic, it will have more hydrophilicity than the first material because the first material is hydrophobic.

(page 4 of the Office Action).

Simply because the Gilman et al. reference uses the term "absorbent layer" as the name of a layer discussed, the name alone does not teach or suggest that the layer has a higher hydrophilicity than that of the cover 12. For instance, the Gilman et al. reference teaches that the absorbent layer 20 could be constructed from the same material as the cover 12. (col. 4, lines 48-52). The Gilman et al. reference further teaches that there are several layers within the laminate structure. (col. 4, lines 41-43). The absorbent layer 20 has apertures therethrough such that pathways are provided to allow "rapid movement of body fluid downward into the primary absorbent 22 and 24." (col. 5, lines 36-39). Nowhere does the Gilman et al. reference teach or suggest that the absorbent layer 20 has a higher hydrophilicity than that of the cover 12. Therefore, the Gilman et al. reference falls to teach all of the claim limitations of amended claim 1.

Second, there is no motivation to modify the Gilman et al. reference. The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*citing* In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). In the Mills case, the claimed invention was directed toward an apparatus for producing an aerated cementitious composition. *In re Mills*, 916 F.2d at 681. The composition was created by driving air into an output pump at a rate that was greater than the feed rate of the pump. *Id.* The cited prior art reference taught that the speed of the prime mover could be controlled by a variable speed transmission. *Id.* at 682. The court found that the teachings of the prior art reference were inadequate to establish a *prima facie* case of obviousness because the cited reference did not require the output pump to run at the claimed speed. *See Id.*

Similar to the Mills case, the Gilman et al. reference teaches that the apertures in the cover 12 and absorbent layer 20 can be created at the same time. (col. 5, lines 30-31). The Gilman et al. reference further teaches that the apertures 18 and 26 "can be formed in a single operation by using mating male and female dies," and one or "both dies may be heated if desired." (col. 5, lines 21-27). However, in order for there to be a fusing of a plurality of fibers between the cover 12 and the absorbent layer 20, the dies would have to be heated to above the melting temperature of the cover 12 and the absorbent layer 20. Although, the mating male and female dies could be modified by heating the male and female dies to above the melting temperature, the Gilman et al. reference does not require the dies to operate at temperatures above the melting point of the cover 12 and the absorbent layer 20. Instead the Gilman et al. reference teaches that the fibers broken during the apeturing process "tend to embed themselves in the fibers of the absorbent layer 20." (col. 5, lines 47-48). This process is important because it prevents the

broken fibers from moving upward as the aperture pins are removed and thereby eliminates the possible skin irritation caused by these broken fibers. (col. 5, lines 48-53). Because the Gilman et al. reference embeds the broken fibers into the absorbent layer, the Gilman et al. reference provides no motivation to make the suggested modification of heating the male and female dies such that a plurality of fibers are fused about the apertures.

Because the Gilman et al. reference does not teach all of the claim limitations of amended claim 1 and because there is no motivation to modify the Gilman et al. reference, the Office Action has not established a *prima facie* case of obviousness. Therefore, Applicants assert that claim 1 is nonobvious over the cited reference and is in condition for allowance. Moreover, because claims 3-12 depend from claim 1, Applicants assert that they too are nonobvious over the cited reference and are also in condition for allowance.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 and 3-12.

Respectfully submitted,
Ludwig Busam et al.

By _____
Jay A. Krebs
Attorney for Applicant(s)
Registration No. 41,914
(513) 626-4856

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